

REMARKS

Claims 1-3 and 6 are now in the application. By this Amendment, claims 4, 5, 7 and 8 have been cancelled without prejudice or disclaimer. The subject matter of these claims is pursued in U.S. Application No. 11/971,931, which was filed on January 10, 2008. No new matter has been added.

The Specification has been amended to correct a typographical error Applicants discovered in the preparation of this response. No new matter has been added.

Claims 1-3 and 6 have been rejected under 35 USC §103(a) as being unpatentable over Eller et al. (U.S. Patent No. 6,362,312) or over Schlitter et al. (U.S. Publication No. 2004/0220381).

Schlitter is not available as an applied citation because it was filed on December 22, 2003, and the earliest date that can be relied upon for Schlitter's priority documents was the February 1, 2003 publication date of the German patent application because the PCT application was published in German. These dates are after the September 27, 2002 priority date of this application. Applicants concurrently herewith file a verified translation of the priority document to comply with formal requirements. In addition, Schlitter is not available as an applied citation under 35 U.S.C. §103(c) because at the time the present invention was made it was commonly owned with that of Schlitter.

Claim 1 recites, among other features, an acid center density of at least 0.25 mmol/g for pK_a values of from 1 to 6. At least this feature cannot reasonably be considered to have been explicitly disclosed by Eller. Instead, Eller suggests, at column 5, lines 41-42 that the acidity is preferably from 0.02 to 0.1 mmol/g at pK_a<-3. Such a statement cannot reasonably be considered to correspond to the above-quoted feature of claim 1.

As further evidence in support of the patentability of the pending claims, and that Eller does not explicitly disclose a catalyst having an acid center density as claimed, Applicants hereby file an English-language translation of the International Preliminary Examination Report (IPER) issued in the international stage of the PCT application. The IPER distinguishes five catalysts suggested in the related art, explaining, for example, that DE 19527532A, a German counterpart to U.S. Patent No. 6,043,388 to Eller et al., does not suggest the claimed acid-centered density of at least 0.25 mmol/g for pK values of 1 to 6, as recited in claim 1.

German application 198 01 462, which is a counterpart to Eller et al. (U.S. 6,362,312), is discussed on page 3 of Applicants' disclosure for suggesting an acid-activated Montmorillonite with an acidity of at least 0.02 mmol/g for pKa values of <-3 and pore volumes of at least 0.4 cm³/g having sizes in the range of 30 to 200 Å. Commercially available clay minerals available as "Tonsil" are referred to in US 6,362,312 on page 5, lines 45 to 48. Tonsil 10 is representative for the other Tonsil clay minerals because it is used in the working examples of US 6,362,312. As set forth on page 8 of the enclosed English-language translation of the IPER, Applicants have demonstrated that commercially available Tonsil does not possess the combination of all of the features of independent claim 1.

For the reasons above, Applicants believe that the pending claims are in condition for allowance. Reconsideration and allowance of the pending claims are respectfully requested.

Should the Examiner believe that an interview would be helpful in further prosecution of this application, the Examiner is invited to contact the undersigned at the telephone number set forth below.

In view of the above, Applicants believe the pending application is in condition for allowance.

Application No. 10/529,035
Amendment dated April 3, 2008
Reply to Office Action of January 10, 2008

Docket No.: 12810-00040-US

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00040-US from which the undersigned is authorized to draw.

Dated: April 3, 2008

Respectfully submitted,

Electronic signature: /Burton A. Amernick/
Burton A. Amernick
Registration No.: 24,852
CONNOLLY BOVE LODGE & HUTZ LLP
1875 Eye Street, NW
Suite 1100
Washington, DC 20006
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant